

REMARKS

Entry of the foregoing, reexamination, and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendment, claims 1-21 have been canceled without prejudice or disclaimer to the subject matter contained therein, and new claims 22-37 have been added. Applicants reserve the right to file one or more continuation and/or divisional applications directed to any of the canceled subject matter. New claims 22-37 are directed to various methods that comprise administering chain isoprenoid fatty acid esters of formula (I). Support for such claims may be found throughout the specification, including, for instance, pages 4-7. Thus, no new matter has been added.

Turning now to the Office Action, the Examiner has rejected claims 1, 3-10, 12, and 16-21 under 35 U.S.C. § 102(b) as allegedly being anticipated by Mori et al. (U.S. Patent No. 5,663,461). This rejection is respectfully traversed.

Applicants note that claims 1, 3-10, 12, and 16-21 have been canceled and therefore this rejection is moot. Moreover, applicants do not believe that the Mori et al. patent teaches or suggests applicants' claimed invention.

It is well established law that for prior art to be anticipatory, every element of the claimed invention must be disclosed in a single item of prior art in the form literally defined in the claims. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 213 U.S.P.Q. 81, 90 (Fed. Cir. 1986). The Mori et al. patent fails to met this requirement as it neither discloses the claimed methods of use nor does it disclose

the chain isoprenoid fatty acid esters of formula (I). Rather, the Mori et al. patent relates to a process for preparing geranyl geraniol.

Since the Mori et al. patent fails to disclose every element of the claims (i.e., claims 22-37), such patent does not, and can not, anticipate the pending claims. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

The Examiner has also rejected claims 1-4, 6-10, 12, and 16-21 under 35 U.S.C. § 103(a) as purportedly being unpatentable over Mori et al. (U.S. Patent No. 5,663,461) in view of WO 99/678809. This rejection is respectfully traversed as well.

This rejection is moot in light of claims 1-4, 6-10, 12, and 16-21 being canceled. Further, applicants do not believe that this rejection applies to the currently pending claims.

As discussed above, the Mori et al. patent does not teach every element of the claims. Moreover, the WO '809 publication fails to remedy the serious deficiencies of the Mori et al. patent.

The Examiner has stated (on page 4 of the Office Action) that "WO '809 describes that geranyl geranoil derivates can be used in pharmaceutical compositions and display bone adsorption-inhibitory action" However, WO '809 describes that isoprenoid compounds block the adverse gastrointestinal effect of the bisphosphonate when orally administered (page 2, lines 19-31, page 3, lines 16-25, page 5, lines 6-8). Additionally, WO '809 does not teach or suggest that the chain isoprenoid fatty acid esters of formula (I) can be used for improving bone metabolism, inhibiting bone absorption, promoting bone formation, or preventing or treating osteoporosis. Therefore, the combination of the Mori et al. patent and WO '809 fail to teach the claimed invention. As such, a proper *prima facie* case of

obviousness has not been established. Withdrawal of this rejection is hence respectfully requested.

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited

In the event that there are any questions relating to this Amendment and Reply, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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